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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 37

CALMAR, INC., *Petitioner,*

v.

COOK CHEMICAL COMPANY, *Respondent.*

On Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit

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BRIEF FOR PETITIONER

OPINIONS BELOW

The opinion of the Court of Appeals is reported at 336 F. 2d 110, and appears at R. 555. The opinion of the District Court for the Western District of Missouri is reported at 220 F. Supp. 414, and appears at R. 17.

JURISDICTION

The judgment of the Court of Appeals was entered on August 21, 1964 (R. 564). A timely Petition for Rehearing En Banc was denied on October 9, 1964 (R. 577). The petition for a writ of certiorari was filed on December 22, 1964, and was granted on March 29, 1965. The jurisdiction of this Court rests on 28 U.S.C. § 1254(1).

QUESTION PRESENTED

Respondent's assignor obtained a patent (Scoggin, No. 2,870,943) purporting to cover the combination, with a finger-operated pump-type liquid sprayer, of a cap designed to hold the plunger of the pump down during shipment, and having various specified mechanical details. It is undisputed that the use of the pump-type sprayer, the use of the cap, and the use of the two together were old.

The question presented is: Whether, because of the addition to these old elements of a ring serving as a sort of washer between the cap and the plunger collar, an addition obvious and disclosed by the prior art, the patent in question embodies a patentable "invention" under the Constitution and §§ 101-103 of the Patent Code?

CONSTITUTIONAL PROVISION AND STATUTES INVOLVED

This case involves Article I, Section 8, Clause 8, of the Constitution, and Sections 101, 102 and 103 of the Patent Code of 1952, 35 U.S.C. §§ 101, 102 and 103. These provisions are set forth in the Appendix, beginning at p. 1a, *infra*.

STATEMENT OF FACTS

Petitioner is a distributor of finger-operated plastic sprayers for dispensing liquids. (R. 72) Respondent is an insecticide manufacturer which, since 1956, has also been engaged in the manufacture of finger-operated plastic sprayers. (R. 50, 55)

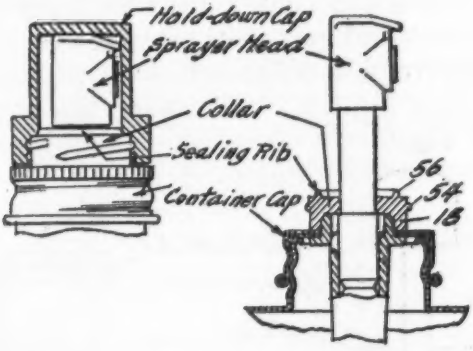
In 1959, U. S. Patent No. 2,870,943 was issued to respondent as assignee of one Baxter I. Scoggin, Jr. (R. 510) Scoggin was Vice President in charge of

production for respondent. (R. 144) The device involved in the patent is shown below:

Scoggin Pat. 2,870,943 Fig. 1

Scoggin Pat. 2,870,943 Fig. 2

(See Ex. 10, R. 510)



At this time, petitioner was selling its plastic sprayer with hold-down cap, which it had developed in 1958 (R. 75, 77), called the Calmar SS-40. This was sold to the trade, including insecticide manufacturers competing with respondent. (R. 74) Respondent charged that petitioner's SS-40 infringed the Scoggin patent. (R. 2, 3) Petitioner then sued respondent in the District Court for a declaratory judgment that the Scoggin patent was not valid, or was not infringed; respondent counterclaimed for infringement. (R. 1-4)

The Scoggin patent had nothing to do with the pump or plunger of the sprayer[1] itself; it simply related to certain details of the cap to be used over the plunger. (R. 512) Moreover, as the District Court found, it

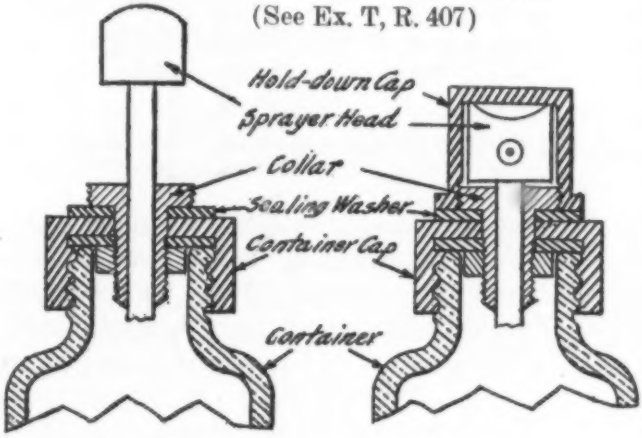
[1] The sprayer, in fact, shown in Scoggin's patent application, and claimed in combination with his bottle cap, was a sprayer of the kind which had then been sold by petitioner to Scoggin's company for years. (R. 55)

was undisputed that there was nothing new in the idea of applying a screw-threaded cap over a liquid-dispenser plunger to hold it down and provide a protective cover and seal over the dispenser during shipment. (220 F. Supp., at 419; R. 26) An early example of this idea is found in Lohse Patent No. 2,119,884, issued in 1938, which had long since expired when the events in suit occurred (R. 407):

Lohse Pat. 2,119,884
Fig. 1.

Lohse Pat. 2,119,884
Fig. 2.

(See Ex. T, R. 407)



The only difference between the device illustrated in the old Lohse patent, and the device in the Scoggin patent—which was manufactured by respondent from August 1957 until November 1959 as the "Bakan 2" sprayer[2]—is that the Scoggin device effects a seal above the screw threads in the cap, while the Lohse device effects a seal below the screw threads. The idea of the cap, like most bottle caps, is to keep the contents in the

[2] The Bakan 2 sprayer, like petitioner's sprayer, is of the sort sold on liquid tire cleaners, spray starches, insecticides, and the like, in supermarkets and grocery stores.

bottle and not let them leak out. The reason for the seal is to prevent any liquid which might have flowed out of or around the plunger into the overcap, from further flowing out of the overcap. In the Scoggin device, in order to make the seal, a flat surface inside the overcap pressed against the top of the plunger collar.

As originally filed, the Scoggin patent application contained fifteen claims which claimed the entire spray pump and plunger, as well as the overcap, in the broadest of terms. (R. 353-354; 243) It was clear that the whole thrust of the original application was to patent the cap on top of the plunger.[3] After rejection of these original claims, the making of further claims, and their rejection in turn (R. 358-69)—in which twenty-four claims were submitted and rejected or cancelled—Scoggin focused in his revised application claims on the seal in the cap.

Presumably because of the abundant prior art disclosing the idea of including a seal in the cap, Scoggin's finally-revised patent application emphasized the provision of a gap or clearance between the bottom of the overcap and the top of the container cap, so that the seal could be effected when the overcap was screwed on. (R. 251, 370-373)[4] However, the District Court

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[3] In fact Scoggin admitted that none of his original claims had anything to do with the sealing of the cap. (R. 169)

[4] This had followed upon an interview at the Patent Office, as Scoggin put it, "courteously granted by the Honorable Examiner and the cooperation received in the drafting of allowable claims." (R. 371) As petitioner's expert, former Patent Commissioner Lawrence Kingsland, put it: "I have seen it happen where there is an interview with the Examiner, and the Examiner says, 'Well, I don't see much in it, but I haven't a direct reference.'" (R. 254)

could not accept the proposition that the "invention" could thus consist of a bit of empty space, and held that the introduction of the seal in the overcap above the threads, in combination with the overcap and plunger, was the patentable feature. (220 F. Supp., at 419-20; R. 26-27)[5]

The idea of effecting a seal for fluids above a thread is old as well as obvious. The common garden-hose coupling employs it in the form of a rubber washer; as, for that matter, does the ordinary screw-type bottle cap. The idea was disclosed in a 1952 patent, relating

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[5] The District Court held that the provision of the gap between the bottom of the overcap and the top of the container cap was "not new or novel" and "not a part of the invention." (220 F. Supp., at 420; R. 27)

Its discussion makes it clear that it viewed the introduction of the seal above the threads, not the gap, as the patentable invention:

> "It is true that Lohse's cap contained threads therein which corresponded to threads on a collar above the container cap, just as there are threads on the collar of the sprayer with which we are concerned here. But the bottom or the skirt of the cap in Lohse forms a seal with a gasket of some substance, apparently leather, which rests on the upper surface of the container cap. There are no seals above the threads and below the sprayer head . . . ."

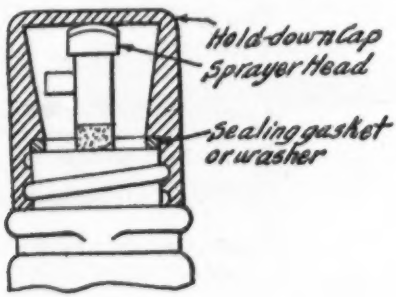
As to the gap:

> "To me this language [referring to the gap] is descriptive of an element of the patent but not a part of the invention. It is too simple, really, to require much discussion. In this device the hold-down cap was intended to perform two functions—to hold down the sprayer head and to form a solid tight seal between the shoulder and the collar below. In assembling the element it is necessary to provide this space in order to form the seal." (220 F. Supp., at 419, 420; R. 26, 27)

The Court of Appeals' opinion does not identify the invention in specific terms, concluding simply that: "the trial court's finding something new was created worthy of patent protection was proper." (336 F. 2d, at 114; R. 561)

to sprayers for insecticides and other liquids, issued to one Mellon[6] (R. 410):

Mellon Pat. 2,586,687
Fig. 3
(See Ex. U, R. 410)



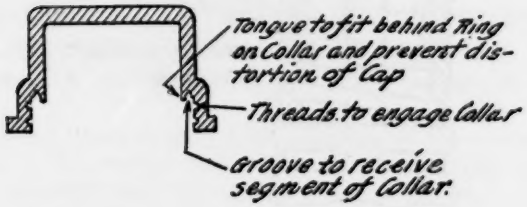
[6] Scoggin was apparently not aware of the Mellon patent until the late stages of the prosecution of his application. (R. 371) Moreover, the Livingstone patents (see p. 8, *infra*) were not even cited in the examination of Scoggin's application. (R. 373) The Livingstone patents disclose not only a seal above the threads, but the provision of a gap between the bottom of the overcap and the top of the container cap to permit the seal to be effected by pressure above the threads before the bottom of the overcap engaged the container cap. (R. 385, 390) It was this feature of the Scoggin application for which the examiner could not find a reference and on the basis of which he presumably permitted the patent to issue. (R. 371-73)

The Livingstone patents did not claim the seal they disclosed, and accordingly under settled doctrine the seal was thereby dedicated to the public—if in fact such a seal, by common use, had not been the public's property for decades or perhaps centuries before. *Edward Miller & Co.* v. *Bridgeport Brass Co.*, 104 U.S. 350, 352 (1882).

We do not mean to suggest that all or any of the prior art patents involved here contained an "invention." The issuance of many of these patents itself is an interesting commentary on the workings of the Patent Office. They are cited here simply as examples of the known "art," if that word is appropriate in a discussion of variations in bottle caps.

Moreover, two patents issued for spout covers to one Livingstone in 1955 and 1956 disclosed this idea; in fact, in a form superior to that exemplified in the Scoggin patent. (R. 385, 390) We illustrate one:

Livingstone Pat. 2,715,480
Cap of Fig. 8
(See Ex. H, R. 385)


Tongue to fit behind Ring on Collar and prevent distortion of Cap
Threads to engage Collar
Groove to receive segment of Collar.

Petitioner's SS-40 used a different type of seal joint from that disclosed in the Scoggin patent and used in respondent's Bakan 2. Petitioner's seal joint (similar to Livingstone's) used a tongue and groove, like that used in wood flooring. This seal joint inhibited the tendency to distortion and leakage present in the simple contact seal illustrated in the Scoggin patent.[7] More important, petitioner's SS-40 had internal pump seals which prevented the liquid from getting out of, or around, the plunger into the overcap. (R. 305-07) Less than a year after the introduction of petitioner's SS-40, publicly admitting the imperfections of the seal of the Scoggin patent,[8] respondent modified its "Bakan 2"

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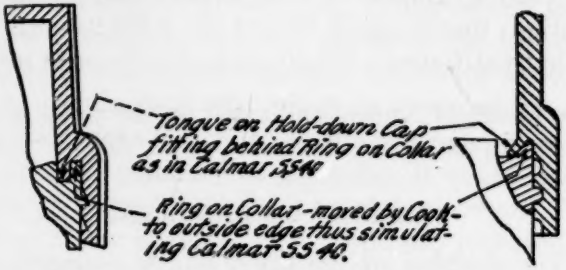
[7] In a later patent application, Scoggin admitted the distortion caused by the very seal which he had patented. (R. 507)

[8] "This new cover cap is designed so that it makes a perfect seal on the collar—which the old one would not do." Cook letter to the trade, R. 341.

to make the overcap seal conform generally to the earlier marketed Calmar SS-40[9] (R. 341):

Calmar SS-40
(See Ex. QQ, R. 475)

Bakan 2—Modified
(See Ex. 90, R. 517)


Tongue on Hold-down Cap fitting behind Ring on Collar as in Calmar SS40
Ring on Collar - moved by Cook to outside edge thus simulating Calmar SS40.

In the District Court, respondent stressed, in support of the validity of the Scoggin patent, the so-called "commercial success" that had attended respondent's production of the Bakan 2 sprayer. The primary evidence adduced on the subject of commercial success was the fact that respondent sold "millions" of the devices.[10] It was, however, undisputed on the record that respondent's sales the first year it introduced the device did not increase over and above those in the year before it introduced the device and may, in fact, have declined.[11] (R. 62)

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[9] This modification (the "Bakan 2 Modified") was on the market in November, 1959. (R. 341) By mid-1960, respondent had also introduced a new model, the Bakan 3, with internal pump seals which, like petitioner's SS-40 introduced over a year before, prevented the toxic contents of the bottle from flowing into the overcap. (R. 157)

We trace the development of the seals involved in Appendix B.

[10] Including, of course, mounting it on its own insecticides, the respondent being a manufacturer of insecticides.

[11] For that matter, respondent sold in excess of 50 million of the old type sprayer which hung on the side of the container without overcap. (R. 64)

The District Court, citing the "evidence" of "commercial success" of Scoggin's patent (220 F. Supp., at 420; R. 28), held that the "combination of the admittedly old and known elements employed by Scoggin" (220 F. Supp., at 419; R. 25) was a patentable invention; that Scoggin Patent No. 2,870,943 was valid; and that petitioner's SS-40 sprayer infringed it.[12]

The Court of Appeals affirmed on the same grounds. (336 F. 2d, at 113-14, 115; R. 560-61, 563)

SUMMARY OF ARGUMENT

I. The decision of the lower courts countenances a debasement of the constitutional standard of invention. The Constitution and the governing statute restrict the grant of the patent monopoly to "inventions" or "discoveries." The decisions of this Court for over a century have insisted upon the requirement of an "invention" or "discovery" as a necessary prerequisite to the validity of a patent grant.

The device involved in this case is a vivid example of the sort of trivial gadget, containing nothing smacking of invention, which the Patent Office on occasion

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[12] The District Court reserved jurisdiction with respect to the amount of damages to be awarded respondent for the infringement; and certified, under Fed. R. Civ. Proc. 54(b), that there was no reason for delay in entering judgment on the issues of validity and infringement, and directed entry of judgment thereon. (R. 37-38) It was only through an extravagant application of the "doctrine of equivalents" of *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950), that the courts below found infringement. As noted, the feature in the Scoggin application found patentable was the seal, and petitioner's device employed an entirely different kind of seal—a "tongue and groove" seal—from the admittedly imperfect pressure-type seal employed by Scoggin. However, in this Court we are simply attacking the validity of the Scoggin patent.

persists in allowing to be patented despite the repeated admonitions of this Court. The so-called "invention" involved here—which was not even focused on in the original patent application — consisted of taking a plunger cap which had been fully disclosed in a twenty-year old expired patent and changing the location of the cap seal to a location in turn taught in an existing patent, and in fact one which is common in every-day applications. Regardless of the precise articulation given the standard of invention, it would be a perversion of language, as well as of law, to call the reshuffling of the elements of a bottle cap involved here, an "invention" or a "discovery."

II. The patent in question here is a combination patent—one covering the bringing together or combining of old elements into a presumably new device. But in the first place, the patent at bar does not even amount to a really new combination, since individual prior patents disclose the combination of the basic elements involved in it. At most, it amounted to a rearrangement combining a particular specific location for the cap seal—a location itself old—with other old elements.

Moreover, the question of validity of a combination patent presents in a particularly acute form the fundamental test that there be an "invention" or "discovery." The decisions of this Court have repeatedly enunciated, as a specific application of the general requirement of "invention", in the context of these combination patents, that: "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function than that theretofore performed or produced by them, is not patentable invention." *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545,

549 (1938). The Scoggin patent is a vivid example of a device that simply combines old parts or elements which in the aggregate do not perform or produce any new or different function or operation from what they perform separately. The feature on which it is now sought to justify the patent—the location of the fluid seal above the screw threads—simply performs what a fluid seal has always performed—it keeps the fluid from flowing over the screw threads and out of the cap. As such it was not patentable.

Patenting a combination of the character involved in the Scoggin patent perverts the patent system by making that system a device to subtract from what is available to the public rather than to add to it. One of the fundamental principles and purposes of the patent system is that the public is to have the right freely to use and, generally, to rearrange, elements taught in old and expired patents, or in patents where the element in question is not claimed. But by countenancing the patenting of the rearrangement of the old elements involved here, the lower courts permitted Scoggin to make a subtraction, in favor of private monopoly, from the public domain.

III. The lower courts here, in effect, permitted the substitution of "commercial success" — and a very attenuated form of it at that — for the basic constitutional requirement of invention. The decisions of this Court have always set their face against this and for good reason.

First, the application of a rule giving serious weight to "commercial success" alters the basis of the grant of the patent monopoly from invention to such factors as sales promotion ability, manufacturing technique,

ready access to markets, consumer-appeal design factors, and advertising budget. The function of these factors in our economy is not to give their possessor a legally-protected monopoly, but to give him a tool with which to wage a *competitive* struggle. It is only *invention* which the patent laws reward with the patent monopoly, and that is all the Constitution permits. Invention, not commercial innovation, has historically been the touchstone of the patent laws.

Second, the introduction of "commercial success" as a decisive factor on the issue of patent validity would improperly and unduly increase the anticompetitive factors already inherent in the operation of the patent system. In a regime in which in fact a great number of patents are issued on devices which contain no invention, any rule which inhibits private diligence and daring in challenging those patents, by increasing the hazard of predicting whether an issued patent is valid or void, tends to put an extra aura of validity around invalid patents. Instead of the classic comparison of the issued patent with the published prior art, the potential competitor of the patentee, in making his judgment as to validity, would be forced into speculation as to matters which were within the private knowledge of the patentee or which might still lie in the future. These considerations, and the growing tendency of the lower courts to deviate from the accepted rule that commercial success is not decisive, indicate that the Court should reiterate that settled rule and strike down the departure from it implicit in the decision below.

ARGUMENT

I. THE DECISION OF THE COURTS BELOW COUNTENANCES A DEBASEMENT OF THE CONSTITUTIONAL STANDARD OF INVENTION

The Patent Office currently grants about fifty thousand patents on the average per year.[13] The patent at bar is one of the 52,470 patents[14] it granted in 1959.

The Patent Office's authority to grant patents—which, once granted, if valid, confer upon the patentee or his assigns the right, for seventeen years, "to exclude others from making, using, or selling" the patented device throughout the United States, 35 U.S.C. § 154—comes from the Patent Code, 35 U.S.C. § 1 *et seq.* The central provision of the Patent Code is Section 101 which states that: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new or useful improvement thereof, may obtain a patent therefor . . ."

Congress' power to provide for these private monopolies in respect of "inventions" or "discoveries" in turn comes from an express and specific provision of the Constitution to the effect that: "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . ." (Art. I, § 8, Cl. 8)—The constitutional provision thus restricts the "exclusive rights" which may be granted (apart

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[13] U. S. Patent Office, Index of Patents (1963), p. 1123.

[14] "The Story of the U. S. Patent Office" (Gov't Printing Office, 4th ed. 1965), p. 36.

from those which relate to copyright protection) to persons who are "inventors," and then only in respect of their "discoveries."[15] The constitutional provision was, of course, written in the late Eighteenth Century against the backdrop of the practices of the English Crown in the indiscriminate granting of exclusive privileges to private persons.[16] At the present time, the patent laws must be harmonized with the basic provisions for free competition contained in the federal antitrust laws.[17]

The decisions of this Court lay considerable stress upon the constitutional requirement of an "invention" or "discovery" as a prerequisite for patentability.

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[15] The first Patent Act passed under the Constitution was enacted by the First Congress on April 10, 1790. (c. 7, 1 Stat. 109) This Act placed the jurisdiction to issue patents in a three-man board consisting of the Secretary of State, the Attorney General, and the Secretary of War. "The leader of the group was the Secretary of State, Thomas Jefferson, who was personally deeply interested in the subject matter of patent law." Federico, Commentary on the New Patent Act, 35 U.S.C.A., pp. 1, 3-4. From these beginnings at which the issuance of patents was located at the high executive levels of government, the patent-granting function has evolved to an extensive administrative institutionalization in the Patent Office. Various reexaminations (35 U.S.C. § 132), administrative appeals (*Id.*, § 134) and *ex parte* judicial appeals to the Court of Customs and Patent Appeals (*Id.*, §§ 141-44) or by way of civil actions in the District Court (*Id.*, §§ 145-46), afford remedies to the applicant who feels he has been improperly denied a patent, but no administrative appeals are provided from decisions granting patents, such as by permitting an interested competitor to contest the grant.

[16] See *United States* v. *Line Material Co.*, 333 U.S. 287, 329-30, 337-38 (1948) (dissenting opinion). *Cf., e. g., The Case of Monopolies*, 11 Coke 84b, 77 Eng. Rep. 1260 (Q.B. 1602); The Statute of Monopolies, 21 Jac. I, c. 3 (1623).

[17] See, *e.g., United States* v. *Masonite Corp.*, 316 U.S. 265 (1942).

While the burden of proof has always been imposed upon him,[18] it has long been open to the defendant in a patent infringement suit to show that the patent of which he has been charged with infringement does not present an "invention" or "discovery" and accordingly is not valid. See *Hotchkiss* v. *Greenwood,* 11 How. 248 (1850). This is because "the public is a silent but an important and interested party in all patent litigation, and is entitled to protection against the monopolization of what is not lawfully patentable." *John Deere Co.* v. *Graham,* 333 F. 2d 529, 535 (8th Cir. 1964), *cert. granted,* No. 11, October Term 1965.

This Court has historically been most careful to enforce the requirement that a basic prerequisite for a valid patent is the presence of an "invention" or "discovery." Thus, in *Electric Cable Joint Co.* v. *Brooklyn Edison Co.,* 292 U.S. 69, 79 (1934), it was stressed that what was required for patentability was "invention, not the mere exercise of the skill of the

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[18] This burden is now codified in § 282 of the Patent Code: "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. . . ."

Any substantive effect the "presumption" might have was, under familiar doctrine, removed by the citation of material prior art not considered by the Patent Office—such as the Livingstone patents which disclosed the very feature which the patent examiner obviously considered made the Scoggin device patentable. See *A R Inc.* v. *Electro-Voice, Inc.,* 311 F. 2d 508, 512-13 (7th Cir. 1962); *Dresser Industries, Inc.* v. *Smith-Blair, Inc.,* 322 F. 2d 878, 888 (9th Cir. 1963). Moreover, any substantive effect of the presumption is removed by the fact that the examiner obviously thought that the "invention" involved in the Scoggin application was the provision of the gap at the bottom of the cap—which the courts below held "not a part of the invention" and "not new or novel." (R. 27)

calling."[19] In *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941), the Court observed that the statute required (as it still does, 35 U.S.C. § 101) that "the device must not only be 'new and useful,' it must also be an 'invention' or 'discovery.' " (*Id.*, at 90)

Enunciating the standard involved and stressing its derivation from the Constitution, this Court has declared that the patentee's "skill in making [his] contribution" must reach "the level of inventive genius which the Constitution, Art. I, § 8, authorizes Congress to reward." (*Id.*, at 91) In *Jungersen* v. *Ostby & Barton Co.*, 335 U.S. 560, 566 (1949), the Court reiterated that the standard of patentability is "inventive genius." In its most recent decision in the field, *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 150 (1950), the Court once again stressed the requirement for "invention."

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[19] This point is an old one and was first made in the leading "doorknob" case of *Hotchkiss* v. *Greenwood*, 11 How. 248, 267 (1850), where it was stated in very similar language. The basic positions as to invention which have persisted ever since were formed even then: The dissenting Justice, whose position was rejected by the Court in *Hotchkiss*, and ever since, declared that it was enough that the doorknob was "new, and better and cheaper than what preceded it." 11 How., at 268. As noted above, § 101 declares that only whoever "*invents* or *discovers* any new and useful process, machine, manufacture, or composition of matter..." may obtain a patent therefor. (Emphasis supplied) Moreover, § 103 of the Code reiterates the fact that what is required is "invention, not the mere exercise of the skill of the calling" by declaring that a patent may not be obtained "if the differences between the subject matter sought to be patented and the prior art such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

One may legitimately entertain serious doubts as to whether, despite the undeniable talents of the American people and the *ex parte* grant of patents by the Patent Office, there are in fact 50,000 inventions made in the United States every year. There have been judicial expressions of skepticism in this respect. A panel of the Court of Appeals for the Second Circuit once dryly commented: "Since 1950, eighteen patents on different variations of hardware for use in reclining chairs with movable leg-rests have been issued. Obviously there have not been eighteen 'inventions' in this narrow area in the last twelve years." *Lorenz* v. *F. W. Woolworth Co.*, 305 F. 2d 102, 105 n. 6 (2d Cir. 1962).

To put it more frankly, the predilection of the Patent Office for issuing patents on devices which are not inventions has been notorious and been the subject of comment by Committees of Congress.[20] The record in this case vividly illustrates the practice it follows in granting a patent if there is any detail, however trivial, not explicitly and completely covered by the prior art. For here the seal of the overcap—which was not even claimed as an invention originally by Scoggin—after the lengthy *ex parte* proceedings in the Patent Office finally emerged as the basis for the grant of the patent. As a commentator has put it: "The situation is aggravated, however, by still other factors. The most serious of these is the *ex parte* nature of the proceedings [before the Patent Office], as a result of which only the examiner's sense of public duty and conscientiousness stand in the way of granting the

[20] See "An Analysis of Patent Litigation Statistics," Staff Report, Subcommittee on Patents, Trademarks and Copyrights, Senate Judiciary Committee, 86th Cong., 2d Sess. (1961), *passim*. See, in particular, the other studies referred to at page 1 of the Staff Report. See also Frank, *Marble Palace* (1958), pp. 24-27, 288.

applicant's request for a patent . . . . The whole thrust of the administrative process in the Patent Office pushes the examiner in the direction of allowing, rather than disallowing, applications." Stedman, *The U. S. Patent System and Its Current Problems,* 42 Texas L. Rev. 450, 476 (1964).

Thus, the exercise of "inventive genius" which the Patent Office finally found in this case consisted of taking a plunger cap which had been fully disclosed in a twenty-year old expired patent (Lohse), and changing the location of the cap seal—to a location in turn taught in a seven-year old patent (Mellon). The technique of the seal was, at the very most, as sophisticated as the common washer, and is old in the art. The patented bottle cap itself—nine examples of which we have lodged with the Clerk—is the strongest witness of the lack of invention in the patent at bar.

While quite likely this case represents the nadir of the issuance by the Patent Office of patents on non-inventions—at least of those which have survived attack through a Court of Appeals—it is hardly an isolated example. The same practice of patenting rearrangements and refinements in petty gadgets has led the Patent Office to patent—and appallingly enough the Courts of Appeals to uphold—a panoply of assorted trivialities in recent years, including insignificant refinements in the art of toilet flushing;[21] vegetable chopping;[22] the hinging of scaffolding;[23]

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[21] *Radiator Specialty Co.* v. *Micek,* 327 F. 2d 554 (9th Cir. 1964), *cert. denied,* 379 U.S. 821 (1964).

[22] *Zysset* v. *Popeil Bros., Inc.,* 276 F. 2d 354 (7th Cir. 1960), *cert. denied,* 364 U.S. 827 (1960), 318 F. 2d 701 (7th Cir. 1963), *cert. denied,* 376 U.S. 913 (1964).

[23] *Beatty Safway Scaffold Co.* v. *Up-Right, Inc.,* 306 F. 2d 626 (9th Cir. 1962), *cert. denied,* 372 U.S. 934 (1963).

the production of ottomans convertible into beds;[24] and the construction of such evidences of man's unfolding knowledge of the physical world about him as metal hair curl clips,[25] rubber earring pads,[26] and rubber coin purses.[27]

Extended discussion is scarcely required to establish that the patent in suit does not push back the frontiers of physics or of mechanics. It is a simple tinker's rearrangement on which the Patent Office has magnanimously bestowed the seventeen-year monopoly which the Constitution and Congress have reserved to inventions.—There has been controversy in the Courts of Appeals as to whether the passage of the 1952 Patent Code was meant to relax the standard of invention taught by this Court's decisions. While we contend that Congress had no such intention—indeed nothing in the text of the Code gives expression to such an intention[28]—we shall not attempt to expand upon the

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[24] *Castro Convertible Corp.* v. *Bebry Bedding Corp.*, 291 F. 2d 306 (2d Cir. 1961), *cert. denied*, 368 U.S. 952 (1962).

[25] *Reiner* v. *I. Leon Co.*, 285 F. 2d (2d Cir. 1960), *cert. denied*, 366 U.S. 929 (1961).

[26] *Norman* v. *Lawrence*, 285 F. 2d 505 (2d Cir. 1960).

[27] *Squeez-A-Purse Corp.* v. *Stiller*, 280 F. 2d 424 (6th Cir. 1960), *cert. denied*, 364 U.S. 828 (1960).

[28] Section 101, as noted, contains the requirement that the "new and useful" device be the product of an invention. No provision of the Code expressly purports to define what an "invention" is, so *prima facie* the test is as set forth in the preexisting judicial decisions. Or, if § 103 is read as providing a definition of an invention through the rather oblique method of setting forth a description of what is not an invention, the fact remains that it is itself a paraphrase of language that has been used in the whole line of cases of this Court on the subject beginning with the *Hotchkiss* case in 1850 through the *Supermarket Equipment* case in 1950.

excellent treatment of the matter by the respondents in No. 11, *Graham* v. *John Deere Co.*, which is to be argued preceding this case.[29] The short of the matter is that regardless of what standard of invention is applied, it is simply a perversion of language, as well as of law, to call the reshuffling of the elements of a bottle cap involved here an "invention" or a "discovery." It is impossible to imagine what sort of gadget could not be patented under whatever standard was applied in the court below, if the decision below were left unreversed. When the respondent contends that the Court below applied the higher of two

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[29] See pp. 47-71, Brief on behalf of Respondents, No. 11, *Graham* v. *John Deere Co.* As that brief points out, the contemporary legislative history of the 1952 Patent Code indicates that the Code was not intended to change the judicial standard of invention, with the exception of the last sentence of § 103 which was meant to prevent an extravagant interpretation which certain sources evidently were putting on a phrase in the opinion of the Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, 89 (1941). Afterwards, certain intimations appeared in the writings of commentators and in certain of the decisions of the courts to the contrary effect. To a large extent this argument depended upon the creation of a myth that sometime in the last few decades before the *Supermarket Equipment* case in 1950, the Supreme Court began to take an approach to the question of patent validity which it had not taken before. But as the respondent in the *Graham* case points out (Brief, pp. 48-54) the approach of the early cases is identical with that of the latter. In fact, as we have pointed out above (n. 19, p. 17, *supra*), the *Hotchkiss* case in 1850 exposes the basic issues and answers them in the way the Court has answered them ever since. Despite the dissent's urging, the Court there held that it was not enough that the device simply was "new, and better and cheaper than what preceded it." (11 How., at 268) The fallacy of the *Hotchkiss* dissent has died hard but this Court has uniformly held that the test is not innovation but invention; the patentable device is one which contains the work of the "inventor," not simply that of the "skillful mechanic." (*Id.*, at 267)

standards (Br. in Op., p. 12), the thought of what sort of devices might be monopolized if a lower standard could be enunciated staggers the imagination.

II. THE SCOGGIN PATENT FALLS VASTLY SHORT OF MEETING THE APPLICATION OF THE STANDARD OF INVENTION CONSISTENTLY DEMANDED OF A VALID MECHANICAL COMBINATION PATENT

The Scoggin patent at bar is what is known in the language of patent law as a combination patent—a bringing together or combining of old elements into a presumably new device. While combination patents have from time to time been sustained by the decisions of this Court, their issuance by the Patent Office presents the courts, in a particularly acute form, with the fundamental problem of finding an "invention" or a "discovery" as a prerequisite to a valid patent. Accordingly, the decisions of this Court have repeatedly enunciated certain specific applications of the general requirement of "invention" applicable to combination patents; and these were disregarded by the courts below.

It should first be noted that the Scoggin patent did not even introduce a really new combination of elements. The basic elements involved—the plunger pump, the overcap screwing onto a collar above the container cap, and a fluid seal—were all brought into combination in the Lohse patent. In fact, the device produced commercially under the Lohse patent—which provided a seal below the threads attaching the overcap to the collar—produced a satisfactory leakproof assembly. (R. 286) Scoggin's "combination" was, rather, in an even more minor key. He simply rearranged the elements already combined in the Lohse patent by relocating the seal above the threads rather than below; or, put another way, he combined with the pump and overcap a simple pressure seal—like

that in a garden-hose coupling—located above the screw threads.

It is indisputable that the spray plunger and hold-down overcap shown in the Scoggin patent were old. Likewise the idea of a pressure seal for fluids above a screw thread to prevent leakage over the threads is old. In Scoggin's rearrangement they did no more than what they did separately.[30]—Put differently, Scoggin's cap housed and sealed a sprayer pump; Mellon's and Livingstone's caps housed and sealed, in the same fashion, a sprayer pump and a pouring spout. Regardless of the application, the function of the elements was the same.

The Court declared in *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545, 549 (1938), that: "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention." Or as the Court put it in its last patent validity case: "The conjunction or concert of

[30] As a matter of fact, the particular form of the elements which Scoggin combined performed their functions rather badly in the combination. This was because the sprayer and overcap assembly, as a practical matter, were to be made of plastic, and the simple pressure seal used by Scoggin in the combination—while adequate in such applications as a garden-hose coupling or in a metal to glass-bottle cap connection—tended to be inadequate where plastics were concerned. In this context, the pressure seal caused distortion of the elements, admitted by Scoggin (R. 507), which permitted leaking of the toxic fluids out of the cap. Thus, it was not long before respondent had to bring out its improved Bakan 2 Modified model, adopting the seal used by petitioner (R. 341), and before Scoggin himself filed a further patent application (R. 496) in which he admitted that existing devices (presumably his own) were prone to leak (R. 497), and that what was needed was a device which prevented leakage into the cap (R. 497)—that is, the internal pump seals already found on petitioner's SS-40.

known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics." *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra,* at 152.

Here, as in the *Supermarket Equipment* case, the "old elements which made up this device" did not "perform any additional or different function in the combination than they perform out of it." (*Ibid.*) The elements "performed no joint function. Each served as separately it had done." *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.,* 307 U.S. 350, 356 (1939). The short of the matter is that the seal above the threads—which is the rearranged element brought into the combination—did not in the combination perform any function other than that historically performed by a pressure seal. Contrast *Leeds & Catlin Co.* v. *Victor Talking Machine Co.,* 213 U.S. 301, 325 (1909); *Lincoln Engineering Co.* v. *Stewart Warner Corp., supra,* at 551-52.

Once again, it must be underscored that the contention—apparently accepted by the courts below[31]—that the result of the Scoggin device was new and useful simply misses the point. As the Court declared as to another mechanical combination patent in *Cuno Engi-*

[31] As we have noted, the Scoggin device was "new" only in that it was the first commercial use in quantity of an in-place sprayer with a hold-down cap on insecticides. Lohse's device, which included such a sprayer and hold-down cap, was successfully marketed commercially in other fluid dispensing applications. (R. 287-88) How "useful" the Scoggin device was in the light of its faulty seal is problematical. See pp. 8-9, and n. 8, p. 8, *supra.*

neering Corp. v. *Automatic Devices Corp., supra,* at 90: "We may concede that the functions performed by . . . [the patentee's] combination were new and useful. But that does not necessarily make the device patentable. Under the statute . . . the device must not only be 'new and useful,' it must also be an 'invention' or 'discovery.'" As this Court declared almost ninety years ago: "Perfection of workmanship, however much it may increase the convenience, extend the use, or diminish expense, is not patentable." *Reckendorfer* v. *Faber,* 92 U.S. 347, 356-57 (1876). The introduction by Scoggin of the old idea of a pressure-type seal above the threads of the overcap in the very narrow and specific application involved here might perhaps be contended to be a new application of an old device;[32] but even "a new application of an old device may not be patented if the "result claimed as new is the same in character as the original result' . . . even though the new result had not before been contemplated." *Cuno Engineering Corp.* v. *Automatic Devices Corp., supra,* at 91.[33]

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[32] But see the pressure-type seal above the cap threads in the Mellon patent, p. 7, *supra.*

[33] Thus, the Nineteenth Century patentees who first had the ideas of, respectively, fitting a detachable rubber eraser on, and fitting a sharpenable rubber eraser into the back end of a lead pencil, certainly had good, novel, and useful ideas—ideas which, we may venture, at their time were of much greater novelty and utility than anything involved in Scoggin's rearrangement. Yet the Court held both their patents invalid. *Rubber Tip Pencil Co.* v. *Howard,* 20 Wall. 498 (1874); *Reckendorfer* v. *Faber,* 92 U.S. 347 (1876).—The *Faber* case is, of course, one of the classic cases on the standard for mechanical combination patents and is an illustrative example of the early adoption of the Court's consistent principle that the rearrangement of old elements, without change in their separate functions, however useful the result, is not patentable.

The reason why this Court has from such an early date carefully scrutinized mechanical combination patents is plain. The purpose of the grant of the patent monopoly is specified in the Constitution: "To promote the Progress of Science and useful Arts." (Art. I, § 8, Cl. 8) The price the patentee pays for a monopoly is the disclosure of his invention to the public—the addition to the fund of public knowledge of his "discovery" in the field of "Science and useful Arts." Thus after the patent has expired the public, instructed in it, may freely practice the discovery it teaches.[34]

To sanction the granting of patents on rearrangements of old mechanical elements perverts the patent system by making it a device to subtract from what is available to the public rather than to add to it. The purpose of the disclosure required under the patent system is to permit the public freely to use the disclosures after the term of the patent. But, if further patents are granted to those simply rearranging old elements already in the public domain, the public is deprived of what belongs to it. For the idea of the system is that the public is to be free to rearrange those elements. As Mr. Justice Jackson eloquently put it for the Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra,* at 152: "The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent

[34] Accordingly, for example, a patent granted on an application which does not adequately teach the invention it embraces is void, since it does not fulfill the function of making an addition to the fund of public knowledge. *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228 (1942); *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U.S. 47 (1938).

for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men. This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly."

III. THE COURTS BELOW ERRONEOUSLY PERMITTED THE SUBSTITUTION OF COMMERCIAL SUCCESS FOR INVENTION

On analysis, it is impossible to find any real basis for the decision below other than the "commercial success" of respondent's sprayer conceived to exist by the lower courts.—Nothing more appears to be meant by the references to "commercial success" by the courts below than the fact that respondent was the first to mass-market liquid insecticides with an in-place plastic sprayer and overcap.[35] This substitution of the "com-

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[35] As noted previously (p. 9, *supra*), the District Court made this finding on the basis of the fact that respondent disposed of "millions" of the devices. But Calmar likewise sold millions of the old-type sprayer, which was hung at the side of the bottle, after the introduction of the Bakan sprayers, or for that matter after the introduction of Calmar's own in-place sprayers. (R. 185) And it is undisputed on the record that the respondent's sales the first year it introduced the device did not increase and in fact may have declined—an odd form of "commercial success." (R. 62)

The record is also clear that the device produced under the Scoggin patent, the Bakan 2 sprayer, was primarily developed for use on respondent's own insecticides, not for sale to other consumer-spray fluid manufacturers. (R. 153) It was not until the next year after respondent introduced its sprayer cap that it began to sell it to other concerns. (R. 153) Not long thereafter respondent was forced to bring out the improved Bakan 2 Modified model adopting the form of seal used earlier by petitioner (R. 341) and, still earlier, by Livingstone's licensee. (R. 294)

The only other evidence of commercial success was the testimony of an executive of a liquid window cleaner concern. He testified

mercial success" of the sprayer for the presence of an invention in the bottle cap shown in the patent finds a reflection in the reasoning of an ominously growing number of recent decisions of the lower federal courts permitting the patenting of trivial mechanical devices.[36]

Once again, the decisions of this Court have warned against this trend. This Court has declared that: "Commercial success without invention will not make patentability." *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra,* at 153. It has characterized "commercial success" as necessarily a "makeweight." *Jungerson* v. *Ostby & Barton Co.,* 335 U.S. 560, 567 (1949). See also *Toledo Pressed Steel Co.* v. *Standard Parts, Inc., supra,* at 356-57. And in words strikingly applicable to the present situation, the Court of Appeals for the Second Circuit has declared that: "In cases of patents on devices improving an existing product, there is every reason to severely limit the weight attributed to commercial

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that his product's sales increased substantially after he began using the Bakan 3 device. But previously, he had furnished no sprayer whatever with his product, though its label's instruction "Spray on" had blithely invited the housewife to make bricks without straw. Moreover, it should be remembered, the Bakan 3 device was respondent's ultimate model, which followed the features of petitioner's SS-40 and not the device disclosed in the Scoggin patent, which was confessedly imperfect. (R. 109, 157, 341, 514, 515)

[36] See *Castro Convertible Corp.* v. *Bebry Bedding Corp., supra,* 291 F. 2d, at 307-08; *Reiner* v. *I. Leon Co., supra,* 285 F. 2d, at 503-04; *Norman* v. *Lawrence, supra,* 285 F. 2d, at 506; *Squeez-A-Purse Corp.* v. *Stiller,* 175 F. Supp. 667, 669 (N.D. Ohio 1959), *aff'd per curiam,* 280 F. 2d 424, *supra; Amp Inc.* v. *Vaco Products Co.,* 280 F. 2d 518, 519 (7th Cir. 1960), *cert. denied,* 364 U.S. 921 (1960); *J. R. Clark Co.* v. *Geuder, Paeschke & Frey Co.,* 259 F. 2d 737, 738 (7th Cir. 1958), *cert. denied,* 359 U.S. 914 (1959).

success. The distinction between a mere improvement and an invention is well known in the law of patents, and incorporation of a device by manufacturers can be explained solely by the former." *Lorenz* v. *F. W. Woolworth Co., supra,* at 104, n. 4.[37]

1. The primary reason for this rule about so-called "commercial success" is evident. Any relaxation of the rule would not only tend to ignore invention—the only constitutional basis for the patent monopoly—but to introduce the most virulent anticompetitive features into the patent system and to destroy the delicate balance which must be maintained between that system and the basic federal policy of free competition implicit in the antitrust laws.

This is because—particularly in the area of mass-marketed consumer goods, like those involved here—

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[37] The District Court so far forgot the classical approach of comparing the patent with the prior art, focusing instead on the march of commercial gadgetry, as to say of the Scoggin patent: "Although hold-down caps had been used for many years, their use on the sprayer was for a special and limited purpose. It was employed in a narrow art, one pertaining primarily to the sealing, shipping and use of insecticides by means of liquefying sprayers." (220 F. Supp., at 421; R. 29) — But Scoggin's patent claims do not specifically relate to the use of the cap with insecticides or any particular liquids.

The opinion of the Court of Appeals also vividly indicates the abandonment of the classic test of comparison of the device taught by the patent with the prior art, in favor of a review of the alleged "commercial success" of the device produced under the patent. The nearest the Court of Appeals came to describing the "invention" was its quotation of a description by the respondent's expert of the commercial use of the invention (336 F. 2d, at 113; R. 559) and the court's reference to the invention as being: "This novel 'marriage' of the sprayer with the insecticide container. . . ." (336 F. 2d, at 113; R. 560), this description likewise being in terms purely of the marketing of commercial gadgets.

the "commercial success" test puts a premium not on invention but on such factors as sales promotion ability, manufacturing technique,[38] ready access to markets, consumer appeal design factors,[39] and advertising budget. These factors may be legitimate tools in the competitive struggle but they are no basis for the grant of a private monopoly.

Thus the approach apparently adopted in the court below favors the vertically integrated operator—like respondent, with a ready captive market for the pump "as a sales promotion gimmick" (R. 51) in its insecticide manufacturing operations; it favors the corporate technician, with immediate commercial outlet for his developments,[40] over the independent inventor; it favors the protection of gadgets with immediate commercial application over the performance of basic research. It tends to create a monopoly on the basis of promotional success or distributional advantage.

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[38] For example, one of the points disclosed in the present record was that a hold-down sprayer, developed by Calmar before the Bakan 2 appeared, ran into difficulties because of certain technical assembly problems caused by the humid atmosphere in Puerto Rico where the assembly was being effected at the time. (R. 74-75)

[39] One of the attractive features of the Bakan 2 device used on respondent's insecticides was that the relatively flat top of the overcap furnished a convenient place for the supermarket to stamp the price. (R. 306) Respondent's president in fact testified that this and appearance factors were among the basic reasons for design of the Bakan 2. (R. 60; see also R. 81)

[40] Scoggin was an officer—Vice President in charge of production—of the respondent corporation. (R. 144)

To say that a corporation which first successfully mass-markets a device having some novelty[41] or innovation in it is to have a seventeen-year monopoly of that product is to renounce the original intent of the patent system—the fostering of invention. "Most important, it must be emphasized that the patent system is written in terms of encouraging and protecting invention, *not* innovation." Stedman, *The U. S. Patent System and Its Current Problems,* 42 Texas L. Rev. 450, 474 (1964). "An increasingly popular contention is that the patent system is not limited to stimulating inventive activity, but plays an equally or more important role in encouraging commercial exploitation and innovation . . . [B]ut the fact remains that our patent system is *not* written in these terms. The criterion for patenting is the creating of an 'invention' . . ." *Id.,* at 454. The theory of our economic system is, of course, that while invention is to be stimulated by the patent monopoly, the fuel of commercial exploitation and innovation is to be the pressure of competition, not the narcotic of monopoly. See *United States* v. *Aluminum Co. of America,* 148 F. 2d 416, 427 (2d Cir. 1945).

2. Moreover, other considerations, intrinsic to the operation of the patent system itself, counsel strongly that the commercial success of a device must not be permitted to remedy the absence of any invention taught in the patent application. The rea-

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[41] The development of the Calmar and Bakan sprayers for liquids was a reaction to the success of aerosol sprayers in the 1950's. These sprayers, containing a gasified liquid, use a built in sprayhead, and it was competitively important to the liquid spray manufacturers to come up with an innovation that would be comparable. (R. 80)

sons are plain. The Patent Office issues many patents on devices which are not inventions and which are held not to be inventions by the courts.[42] But unless someone is willing to take the risk of an infringement suit, the effect of these invalid patents is as exclusionary and monopolistic as that of a valid patent.

In order to decide whether what is embraced by the Patent Office's grant of a patent is—as unfortunately it frequently is—not an invention, a competitor or potential competitor of the patentee must obtain advice on the patent's validity. That advice, classically, has been given on the basis of a technical and legal examination of the prior art of public record and a setting of the patent in question against it. To add to this sort of analysis the necessity for evaluating the factor of "commercial success" of the device or devices produced commercially under the patent is to introduce enormous additional uncertainties into the process. It substitutes matters within the private knowledge and control of the patentee for the objective facts of public record as the governing criteria. Indeed, it may require the potential competitor to engage in prophecy as to what the future market success of the patentee's product will be. It tends to expand the issues in patent cases and to make patent litigation more vexatious in terms of time and expense.

The introduction of the factor of commercial success as a decisive or seriously consequential factor on the issue of patent validity—as sanctioned by the courts below—thus cannot help but have the effect of endowing patents which are invalid, and which would be challenged as such, with a practical aura of validity

[42] See n. 20, p. 18, *supra*.

by discouraging attempts to challenge them.[43] Thus the anticompetitive effects necessarily present in the patent system would be expanded beyond their legitimate bounds, and the consequences of the *ex parte* procedures in the Patent Office and its proclivity for issuing patents on devices which are not inventions would be worsened.

CONCLUSION

For the reasons stated, the judgment of the Court of Appeals should be reversed, and the case remanded to the District Court with instructions to grant petitioner's prayer for a declaratory judgment that the

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[43] And certainly no more effective method of discouraging challenges of invalid patents could be devised than that which the District Court hit upon here. The District Court found that the "extensive commercial success" of the respondent's patented device "was evidenced by the fact that Calmar almost immediately set out to produce an equally successful shipper sprayer." (220 F. Supp., at 420; R. 28) Thus from the competitor's conclusion that a patent is invalid, and his decision to challenge it by mass-producing an item on which the patent may read, is deduced a "commercial success" of the device described in the patent; and from that "commercial success," under the District Court's reasoning, is deduced the validity of that patent.

Scoggin patent is not valid, and to dismiss respondent's counterclaims.

Respectfully submitted,

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August, 1965

APPENDIX A

Constitutional and Statutory Provisions

1. Article I, Section 8, Clause 8, of the Constitution provides:

> The Congress shall have Power . . .
>
> . . . .
>
> To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. . . .

2. Sections 101, 102 and 103 of the Patent Code of 1952 provide (35 U.S.C. §§ 101-03):

§ 101. Inventions patentable

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability; novelty and loss of right to patent

> A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

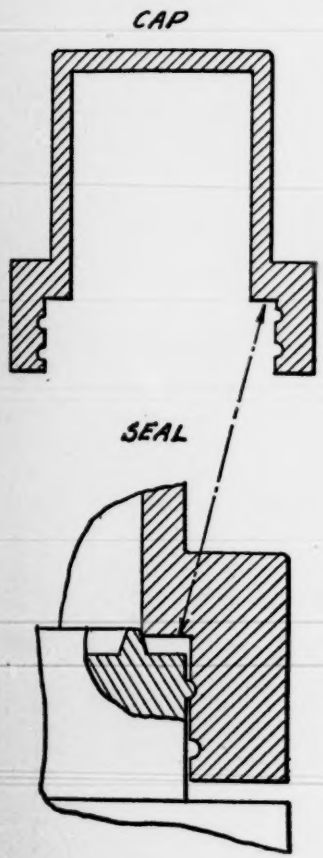
§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

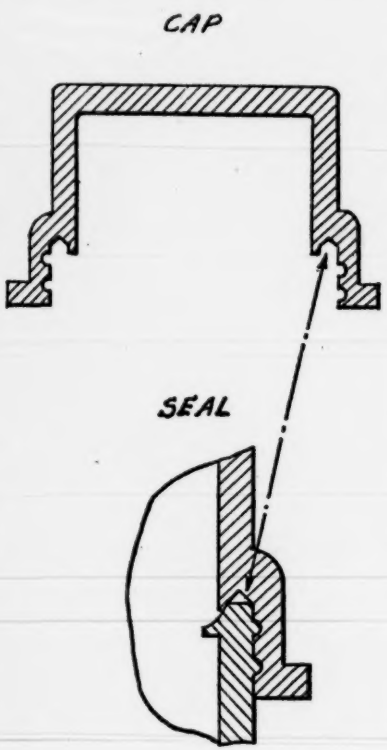
APPENDIX B

The Specifics of the Various Over-the-Thread Seals Involved

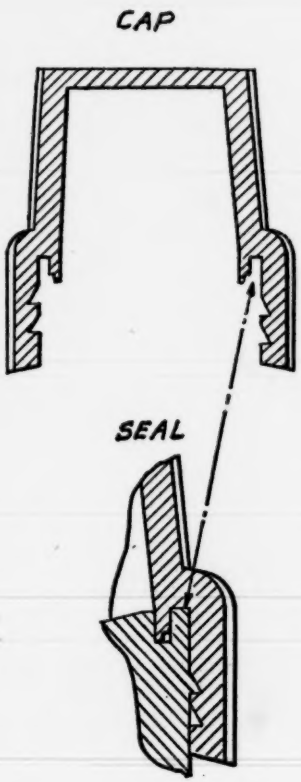
COOK'S BAKAN 2
As produced under the Scoggin patent in suit.
Produced Aug. 1957
Abandoned Nov. 1959
See Ex. 10, R. 510



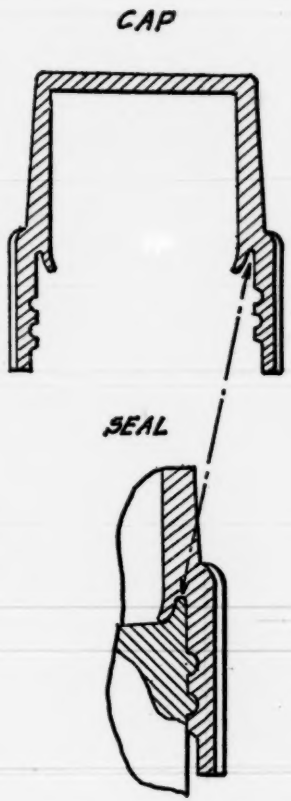
An Example of the Prior Use of a Seal Positioned Like, but Superior in Technique To, Scoggin's
1955 LIVINGSTONE
Patent Fig. 8.
See Ex. H, R. 385



CALMAR's SS-40
The Accused Device
Produced from Jan. 1959
See Ex. QQ, R. 475



COOK'S
BAKAN 2, MODIFIED
Announced in Nov. 1959
See Ex. 90, R. 517



COOK'S BAKAN 3
Produced from 1960
See Ex. EE, R. 434